Paper No. 26

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte STEPHEN V. CHENOWETH,
JEROME A. OTTO and
DONALD C. JOHNSON

_____

Appeal No. 96-3681
Application 08/234,450[1]

_____

ON BRIEF

_____

Before THOMAS, MARTIN and BARRETT, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

[1] Application for patent filed April 28, 1994.

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 6 and 19 through 22, which constitute all the claims remaining in the application.

Representative claim 1 is reproduced below:

1. A label for a merchandise item comprising:

an electronic memory containing a permanent record of information about the item;

wherein the memory is permanently affixed to the merchandise item.

The following reference relied on by the examiner:

Johnsen	5,151,684	Sept. 29, 1992

Inasmuch as the existing art rejections from the final rejection were withdrawn in the answer, claims 1 through 6 and 19 through 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Johnsen in a new ground of rejection set forth in the initial answer. The rejection of certain claims under the second paragraph of 35 U.S.C. § 112 set forth in this initial answer was withdrawn in the supplemental answer in view of the amendment filed on April 2, 1996 with the reply brief, both of which have been entered by the examiner.

Rather than repeat the positions of the appellants and the examiner, reference is made to the briefs and the answers for

the respective details thereof.

OPINION

As to the outstanding rejection of claims 1 through 6 and 19 through 22 under 35 U.S.C. § 102 as being anticipated by Johnsen, we sustain only the rejection of independent claim 20 and reverse the rejection of all remaining claims.

We reverse the rejection of independent claims 1 and 19 on appeal since both of these claims contain the recitation that the claimed electronic memory “is permanently affixed to the merchandise item.” Appellants' argument at page 6 of the reply brief is well taken that Johnsen's tag device 10 in Figures 1 and 2 is not permanently affixed because the tag device is removed during the checkout process to be reused in the store with other merchandise. From the examiner's perspective, the discussion at column 4, line 66 through column 5, line 19 of Johnsen is perhaps the best statement of the nature of the attachment or affixation of Johnsen's tag device 10 to the merchandise item. However, this portion of

the reference also indicates that once the merchandise item in Johnsen has been purchased, the clamping mechanism utilized to clamp the entire tag device 10 to the merchandise item is released. The end of the abstract indicates that the connector is detached upon receipt of a signal indicating that the merchandise item has been sold. Column 6, lines 17 through 19 indicate that the merchandise tag will be removed once the item is purchased. Column 8, lines 53 though 55 state that "[o]nce the tag device has been processed through the point-of-sale system, the tag device may be reprogrammed for attachment to a new article of merchandise."

The entire discussion of Figure 10 beginning at column 11, line 49 through the end of the patent indicates similar teachings. As to this figure, it is also noted at column 12, lines 18-21, that once a valid authorized sale of the merchandise has occurred, the point-of-sale device will enable the tag detacher device to use its unclamping mechanism to detach the tag device. Finally, at column 13, lines 25 through 27, once a point-of-sale purchase has been made as in Figure 10 "the removed tag device can be reused."

Thus, according to the teachings in Johnsen, there is no permanent affixation of Johnsen's tag device, including its internal memory 34 of Figure 2, to the merchandise item. As such, we reverse the rejection of independent claims 1 and 19 and the rejection of dependent claims 2 through 6 as well.

Before proceeding to consideration of the other independent claims on appeal, we observe in passing that the subject matter of claim 2/1 appears identical to that which is set forth in independent claim 19 on appeal. Thus, there would appear to
be a violation of 37 CFR § 1.75(b) as to the avoidance of substantially duplicate claims.

We also reverse the rejection of independent claim 21 on appeal. The preamble of this claim requires a label for a "purchased merchandise item," which quoted language is also recited in the body of the claim on appeal. More specifically, the wherein clause of claim 21 recites that the electronic memory is an integral part of "the purchased merchandise item." In view of the earlier noted portions of Johnsen with respect to our reversal of independent claims 1 and 19 on appeal, it is apparent that the tag device of 10 of

Johnsen is not retained upon nor does it form a part of the purchased merchandise item. In other words, once the item in Johnsen has been purchased, the tag device 10 is removed therefrom. Therefore, the feature of the electronic memory forming an integral part of the purchased merchandise item at the end of claim 21 on appeal can not be met by the teachings in Johnsen. Thus, the rejection of this claim under 35 U.S.C. § 102 must be reversed as well as its respective dependent claim 22.

Finally, we sustain the rejection of independent claim 20.

As to this claim appellant argues-in-part at the bottom of page 5 of the reply brief that because Johnsen's label is deactivated during checkout, there is no true “permanent record” of the information about the item as required by this claim. Initially, there is no requirement in the claim for a permanent record after purchase or other type of checkout of the merchandise item associated with the claimed label. Therefore, appellants' argument is more specific than the actual scope of the claim on appeal. Inasmuch as Johnsen's information is changeable over its life cycle from the

manufacturer through a potential point-of-sale terminal, this changeability feature of Johnsen is similar to appellants' changeability feature of the same information retained by his disclosed label 10 during its life cycle (Spec. at 5, lines 22-25). In other words, the information in Johnsen is as permanent as appellants' disclosed record of information is. There is no structural limitation or attribute that may be associated with the language “permanent record” of claim 20. If the item is never sold or never passes through a checkout of some kind through a point-of-sale terminal or the like in Johnsen, it remains as permanent as appellants' argument intends.

We also do not agree with appellants' argument at page 6 of the reply brief with respect to claim 20 on appeal relating to the expression that the electronic memory is an integral part of the merchandise item. According to the comprehensive teachings in Johnsen, Johnsen's tag device 10 is as much an integral part of the device during its manufacture and distribution through various warehousing approaches and eventual arrival at a store for potential sale as is disclosed and argued by appellants. Again, there is no requirement of

claim 20 that the electronic memory form an integral part of a purchased item as discussed earlier with respect to independent claim 21 on appeal. We also note again that if the item is never sold or otherwise passed through a point-of-sale terminal in Johnsen, it still remains an "integral part" of the merchandise item to the same extent argued by appellants. To the extent broadly recited and argued, the earlier noted teachings at column 4, lines 66 through column 5, line 19 indicate that Johnsen's tag device 10 forms an "integral part" the merchandise item in Johnsen to the same extent as claimed. This noted portion as well as the entire substantive teaching in Johnsen conveys that Johnsen's tag device 10 becomes a constituent part of the merchandise item as the ordinary meeting of "integral" conveys.

In view of the foregoing, the decision of the examiner rejecting claims 1 through 6 and 19 through 22 under 35 U.S.C. § 102 is sustained only as to claim 20. We have, therefore,

reversed the rejection of claims 1 through 6, 19, 21 and 22.

As such, the decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JAMES D. THOMAS Administrative Patent Judge	)
JOHN C. MARTIN Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
LEE E. BARRETT Administrative Patent Judge	)

JDT/cam

Paul W. Martin
Law Department EDC 2
AT&T Global Information Solutions Co.
Dayton, OH 45479-0001